The Examiner rejected Claims 1-19 under 35 U.S.C. 103(a) as being obvious in view of the combined teachings of the Joao and Bond references. These rejections are respectfully traversed.

Independent Claim 1 defines the invention as a method for benchmarking data relating to an asset. Initially, a group of assets is selected that are included in a pool of benchmarking information on a computer. Then, on a computer, an asset characteristic relating to an asset included in the pool of benchmarking information is identified. A benchmark heuristic is next invoked on a computer to generate a benchmark value relating to the identified asset characteristic. At least two organizations contribute to the pool of benchmarking information.

The Examiner noted that the Joao reference discloses only the initial step of Claim 1, namely, selecting a group of assets that are included in the pool of benchmarking information on a computer. The Examiner acknowledged that the Joao reference does not disclose any of the other steps of Claim 1, namely, (1) identifying on a computer an asset characteristic relating to an asset included in the pool of benchmarking information; (2) invoking a benchmark heuristic on a computer to generate a benchmark value relating to the identified asset characteristic; and (3) wherein at least two organizations contribute to the pool of benchmarking information. To address the deficiencies of the Joao reference, the Examiner relied upon the Bond reference.

However, for the reasons set forth below, the Bond reference is non-analogous art to the claimed invention and, therefore, should not be considered at all when evaluating the patentability of the claimed invention. Furthermore, even if the Bond reference is properly considered, the teachings thereof diverge from the teachings of the Joao reference and, consequently, cannot be properly combined therewith. Lastly, even of the teachings of the Bond reference are properly combined with the teachings of the Joao reference, the claimed invention is not obvious in light thereof.

The Bond reference is non-analogous art to the claimed invention and, therefore, should not be considered at all when evaluating the patentability of the claimed invention. As set forth in Section 2141.01(a) of the MPEP, a reference must

either be (1) in the field of the applicant's endeavor or (2) reasonably pertinent to the particular problem with which the inventor was concerned. With respect to the latter test, a reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem.

With respect to the first leg of this test for analogous art, the field of the Bond reference (namely, providing an estimate for building a capacity modeling and planning function in an information technology organization) is quite different from the field of the claimed invention (namely, a computer based system that automatically gathers and analyzes information relating to the procurement and utilization of a plurality of assets). Thus, the field of the Bond reference is clearly not within the field of the claimed invention.

With respect to the second leg of this test for analogous art, the problems addressed by the Bond reference (namely, the difficulties associated with adequately managing information technologies in a complex business environment including idea conception, strategy development, capability delivery, planning, administration, operation, coordination of project requests, change administration, and managing demand for discretionary and non-discretionary activities and operations) are quite different from the problems addressed by the claimed invention (namely, the difficulties in capturing and retaining information relating to cost and utilization of assets on a company-wide or industry-wide basis in order to facilitate better procurement and other business decisions). Thus, the Bond reference is clearly non-analogous art to the claimed invention and, therefore, should not be considered at all when evaluating the patentability of the claimed invention.

However, even if the Bond reference is properly considered, the teachings thereof significantly diverge from the teachings of the Joao reference and, consequently, cannot be properly combined therewith. The Joao reference relates to an apparatus and method for processing lease insurance information wherein:

> a first data set (containing information for generating at least one of an insurance premium and an insurance policy for providing insurance for excess wear and tear for a leased entity) is compared with
>
> a second data set (containing information regarding at least one of the entity to be leased and a term of the lease) and
>
> a third data set (containing information regarding at least one of a driving history of a leasing individual, a driving history of a leasing entity, a usage history of a leasing individual, a usage history of a leasing entity, an insurance history of a leasing individual, an insurance history of a leasing entity, a past leasing history of a leasing individual, a past leasing history of a leasing entity, a desired lease insurance coverage, a lease insurance deductible, and a lease insurance policy term).

The Bond reference, on the other hand, relates to a method for providing an estimate for building a capacity modeling and planning function in an information technology organization wherein:

> a plurality of estimating factors is obtained;
>
> a difficulty rating is determined for each of the estimating factors;
>
> a time allocation is generated for building the capacity modeling and planning based on the estimating factor and the difficulty rating; and
>
> a cost is generated for building said capacity modeling and planning based on said time allocation.

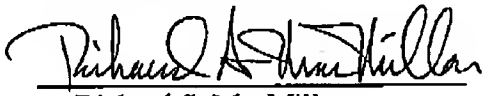
Because of these significant differences in the disclosures of the two references, a person of ordinary skill in the art would not combine the teachings of the Joao and Bond references in the manner suggested by the Examiner.

Lastly, even of the teachings of the Bond reference are properly combined with the teachings of the Joao reference, the claimed invention is not obvious in light thereof. As mentioned above, the Joao reference relates to an apparatus and method for processing lease insurance information, while the Bond reference relates to a method for providing an estimate for building a capacity modeling and planning function in an information technology organization. A proper combination of the teachings of these two references would result in a method that not only processes

lease insurance information (in accordance with the Joao reference), but also provides an estimate for building a capacity modeling and planning function in an information technology organization (in accordance with the Bond reference). This combination of teachings does not show or suggest the claimed method for benchmarking data relating to an asset wherein (1) a group of assets is selected that are included in the pool of benchmarking information on a computer; (2) an asset characteristic is identified on a computer relating to an asset included in the pool of benchmarking information; and (3) a benchmark heuristic is invoked on a computer to generate a benchmark value relating to the identified asset characteristic, wherein at least two organizations contribute to the pool of benchmarking information. Thus, the invention recited in independent Claim 1 is clearly patentable over the combined teachings of the Joao and Bond references.

Independent Claims 9 and 19 each define the invention as a system for benchmarking data relating to an asset in a manner that is similar to independent Claim 1. Thus, for the same reasons set forth above, such claims are also clearly patentable.

Respectfully submitted,



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